

REMARKS

Initially, Applicants have amended claims 1, 10, 15, 21, and 22. In addition, Applicants have added new claims 31-36. No new matter has been added. Applicants believe that the foregoing comments overcome the rejections set forth in the June 27, 2005 Office Action. A Request for Continued Examination is being filed concurrently with this response.

I. THE EXAMINER'S REJECTIONS

The Examiner rejected Claims 1, 2, 7-10, 12-15, 17-25, and 27 under 35 U.S.C. § 103(a) as being unpatentable over Walker *et al.*, U.S. Patent Application Pub. No. 2003/0054888 (hereinafter "Walker") in view of Ghouri *et al.*, U.S. Patent Application Pub. No. 2002/0082978 (hereinafter "Ghouri").

The Examiner rejected independent claims 1, 10, 15, 21 and 22 by applying the same arguments to each claim. More specifically, the Examiner cited Walker to show every element of independent claims 1, 10, 15, 21 and 22; however, the Examiner admitted that Walker does not expressly teach the use of dealers. *See, e.g.*, Office Action dated 6/27/2005, page 4. In the Examiner's view, "Ghouri teaches a system that searches for dealers of products selected by users." *Id.* In addition, according to the Examiner, "Walker teaches third party manufacturers of products." *Id.* As a result, the Examiner opined that "it would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that Walker would use the Ghouri system to display to users a list of different dealers or manufacturers of users' selected products." *Id.* Accordingly, the Examiner concluded that the combination of references "would show to users the best dealers or manufacturers' offers of products selected by users." *Id.*

II. THE EXAMINER'S REJECTIONS SHOULD BE WITHDRAWN

In order for a claimed invention to be obvious, either alone or in view of a combination of references, three criteria must be met: 1) there must exist a suggestion or motivation to modify the reference or to combine reference teachings; 2) there must be a reasonable expectation of success; and 3) the prior art references, when combined, must teach or suggest all of the claim limitations. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991); MANUAL OF PATENT EXAMINING PROCEDURE § 2143-2143.03.

Applicants respectfully submit that there is no motivation to combine the references. It is well settled that an obviousness rejection is improper unless the prior art relied upon suggests the proposed combination. *See In re Bond*, 910 F.2d 831, 15 USPQ2d 1566 (Fed. Cir. 1990).

Indeed, the Examiner “has the burden to show some teaching or suggestion in the references to support their use in the particular claimed combination.” *SmithKline Diagnostics, Inc. v. Helena Laboratories Corp.*, 859 F.2d 878, 887, 8 USPQ2d 1468, 1475 (Fed. Cir. 1988); *see also, In re Mayne*, 104 F.3d 1339, 1342, 41 USPQ2d 1451, 1454 (Fed. Cir. 1997) (“When relying on numerous references or a modification of prior art, it is incumbent upon the examiner to identify some suggestion to combine references of make modification.”). A finding of obviousness is not warranted if, as in the present case, there is an absence of such teaching, suggestion or

motivation. *See Gambro Lundia AB v. Baxter Healthcare Corp.*, 110 F.3d 1573, 1579, 42 USPQ2d 1378, 1383 (Fed. Cir. 1997). The prior art references relied upon by the Examiner fail to provide any teaching, suggestion or motivation for the combination asserted by the Examiner in rejecting the pending claims. “Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination. Under section 103, teachings of references can be combined only if there is

some suggestion or incentive to do so.” *ACS Hospital Systems Inc. v. Montefiore Hospital*, 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984).

More specifically, Applicants respectfully submit that there is no motivation for the combination of Walker in view of Ghouri. In the present rejection, the Examiner stated, with respect to the combination of Walker in view of Ghouri that “it would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that Walker would use the Ghouri system to display to users a list of different dealers or manufacturers of users’ selected products.” *See* Office Action, page 4.

Applicants respectfully submit that the proffered motivation is improper. Walker discloses a method wherein an individual retailer can increase the excitement associated with the shopping experience. The increased excitement attracts a greater number of customers capable of purchasing items at the retail store. These customers, in turn, are induced to purchase some of the retail store’s products, increasing the overall profitability of the retail store.

To increase the excitement associated with shopping, a customer has the option to win a product from a retail store outright for a small percentage of the item’s cost. Alternatively, a customer can apply the cost associated with winning the product as a credit towards the purchase of the desired item. The product can be manufactured by a third-party, however, it must be offered for sale at the retail store for it to generate customer excitement, and in turn, increased profits.

Ghouri discloses a method wherein a user customizes a product, such as an automobile, by using a program which is accessed from the Internet. After customizing the product, the user stores the results in a database for a fee. After the information is stored and the fee is paid, a notification is sent to multiple participating retailers of the customizable product. The retailers,

in turn, offer the product to the user for a specified price. Each retailer has access to the other offers, and can modify its offer accordingly. For example, if the retailer wants to sell the item but does not have the lowest offer, it may lower the asking price for the product to make it more attractive for purchase by a user. The system, known as a reverse auction, is designed to provide the user with the lowest possible price for a particular product. As a result, a retailer who uses the Ghouri system will actually receive less profit for a product than it normally would.

As a result, Applicants respectfully submit that the references teach away from each other. As such, they are not combinable. For example, the Walker reference results in increased profits for a single retail store, while Ghouri teaches a system that is designed for use by multiple retailers which results in lower profits by the retailers via lowered prices to the consumer.

Accordingly, one of ordinary skill in the art would not be motivated to combine the two references. In addition, the cited references provide no other motivation or incentive for the combination suggested by the Examiner. Therefore, the obviousness rejection could only be the result of a hindsight view with the benefit of Applicant's specifications. This type of analysis is inappropriate:

"To draw on hindsight knowledge of the patented invention, when the prior art does not contain or suggest that knowledge, is to use the invention as a template for its own reconstruction -- an illogical and inappropriate process by which to determine patentability. The invention must be viewed not after the blueprint has been drawn by the inventor, but as it would have been perceived in the state of the art that existed at the time the invention was made." *Seasonics v. Aerosonic Corp.* 38 USPQ 2d 1551, 1554 (1996) (citations omitted).

Accordingly, the combination advanced by the Examiner is not legally proper -- on reconsideration the Examiner will undoubtedly recognize that such a position is merely an "obvious to try" argument.

At best, it might be obvious to *try* such a modification, but of course, “obvious to try” is not the standard for obviousness under 35 U.S.C. § 103. *Hybritech, Inc. v. Monoclonal Antibodies, Inc.*, 231 USPQ 81, 91 (Fed. Cir. 1986).

Under the circumstances, Applicants respectfully submit that the Examiner has succumbed to the “strong temptation to rely on hindsight.” *Orthopedic Equipment Co. v. United States*, 702 F.2d 1005, 1012, 217 USPQ 193, 199 (Fed. Cir. 1983):

“It is wrong to use the patent in suit as a guide through the maze of prior art references, combining the right references in the right way so as to achieve the result of the claim in suit. Monday morning quarter backing is quite improper when resolving the question of non-obviousness in a court of law.” *Id.*

Applicants submit that the only “motivation” for the Examiner’s combination of the references is provided by the teachings of Applicant’s own disclosure. No such motivation is provided by the references themselves. Therefore, the rejection should be withdrawn.

Further, if the references were combined using the rationale proffered by the Examiner, Walker would be rendered inoperative for its intended purpose. According to the Examiner, “it would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that Walker would use the Ghouri system to display to users a list of different dealers or manufacturers of users’ selected products.” *See* Office Action, page 4. However, such a combination would result in a state where Walker competed with itself by offering products sold by the competition. Accordingly, the system of Walker will not operate as intended, by offering its products with the added incentive of a chance to win a product, but rather would allow users the opportunity to win a product without the benefit of a possible sale, which may go to the third party vendor. Indeed, the Examiner admitted that such a combination “would show to users the best dealers or manufacturers’ offers of products selected by users.” *See* Office Action, page 4.

It is well settled that “if a proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification.” MANUAL OF PATENT EXAMINING PROCEDURE § 2143.01 (citing *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984)). Since the Examiner’s proposed modification of Walker in view of Ghouri would render Walker unsatisfactory for its intended purpose, there can be no motivation to combine the references. Therefore, the Examiner has failed to establish a *prima facie* case of obviousness and the rejections should be withdrawn.

Even if the combination of Walker and Ghouri is proper, the combined references do not disclose the present invention as amended. The resulting system of Walker in view of Ghouri would result in a system that provides a user with the opportunity to win or directly purchase a particular product from the party offering the product for sale. In addition, the combination would allow third-party vendors to compete with the individual retailer by offering the item directly to the user at a lower cost.

In contrast, the present invention comprises an improved shopping search engine. When a user enters criteria related to a specific product, the search engine displays one or more third-party web pages that offer the particular product for sale. When the results are displayed, the user has the option to attempt to win the prize via one or more games of chance. Alternatively, the user can simply click on one of the third-party vendor’s links and purchase the product. Both options are available to the user from one interface immediately after generating the appropriate search. If the user wins the product, the search engine purchases the product from the third-party vendor on behalf of the user. As a result, the present invention does not directly offer products for sale.

In addition, the present invention merely lists third-party vendors who offer the product that a user wishes to purchase and/or win. It does not directly offer products for sale to a user, nor does it allow third-party vendors to compete with each other via a reverse auction as required by Ghouri. Neither Walker nor Ghouri discloses a search engine which provides the user with an opportunity to purchase the product from a third-party vendor as required by the amended claims. Instead, Walker discloses the direct sale of a product which can be manufactured by third parties by an individual retailer. Ghouri requires that the third party vendors offer the product directly to the consumer. It does not allow the consumer to purchase the product in response to a search query. Rather, a user of the Ghouri system must wait until she receives an offer for the desired product. Since Walker and Ghouri, individually and in combination, fail to disclose the present invention as amended. Applicants respectfully submit that the Examiner's rejection under 35 U.S.C. § 103 is improper and should be withdrawn.

Further, the present invention does not require the user to input any sensitive personal information to win the item sought. The systems of Ghouri and Walker require the end user to enter information related to the user's name, address, and credit card information, which can be tracked by marketing agencies and the like to determine a user's buying tastes, etc. As a result, the user frequently receives unwanted promotional materials based on the inputted information. In contrast, the present invention does not require the user to input any sensitive personal information. A user of the present invention merely enters a contest with a predetermined winning percentage. Consequently, the user of the present information does not receive unwanted promotional materials and the like.

Thus, the present invention for the first time discloses a novel search engine with an option to win the item sought. This represents a vast improvement over the prior art. Further,

- “ the cited references neither teach nor suggest the novel and non-obvious features of this
- invention.

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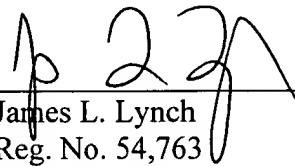
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CONCLUSION

Applicants submit that the specification, drawings, and all pending claims represent a patentable contribution to the art and are in condition for allowance. No new matter has been added. The claims have been amended merely to clarify the novel features of the current invention and are in no way related to patentability. Early and favorable action is accordingly solicited.

Respectfully submitted,

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